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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In : U.S. Patent Application of GARY HOCHMAN
Filed : August 20, 2003
S.N. : 10/644,246
For : **Method For Transmission Of Image Data**
Attorney's Docket: 0813-017P/JAB

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**SUBMISSION OF
APPLICANT'S PRE-APPEAL BRIEF**

Sir:

Transmitted herewith is Applicant's Notice of Appeal, a check in the sum of \$315 to cover the PTO Notice of Appeal fee (Small Entity) and PTO fee for a one-month extension (Small Entity). Also enclosed are a Pre-Appeal Brief Request For Review, a Pre-Appeal Brief, and a return receipt postcard.

The Commissioner is hereby authorized to charge payment of any fee deficiency or credit any overpayment to Deposit Account No. 19-0748.

Any additional fees associated with the filing of this Pre-Appeal Brief.


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Attorney For Applicants

Date : October 26, 2007

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CERTIFICATE UNDER 37 C.F.R. 1.8(a)

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Carol L. Wood: 

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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

0813-017P/JAB

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name _____

Application Number

10/644,246

Filed

20 AUG. 2003

First Named Inventor

G. HOCHMAN

Art Unit

2625

Examiner

S.E. DEHKORDY

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒ attorney or agent of record.
Registration number 28,188

☐ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 _____


Signature

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Telephone number

OCTOBER 26, 2007

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☒ *Total of 1 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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Attorney Docket #0813-017P/JAB

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re : U.S. Continuation Patent Appln. of GARY HOCHMAN
S.N. : 10/644,246 Group Art Unit : 2625
Filed : 08/20/2003 Examiner : S. Ebrahimi Dehkordy
For : **METHOD FOR TRANSMISSION OF IMAGE DATA**

New York, NY
October 26, 2007

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF

Sir:

The claims of the present application stand finally rejected as being either anticipated by U.S. Patent 5,657,381 to Hughes-Hartogs (claims 1-8 and 10-14) or obvious and unpatentable over Hughes-Hartogs in view of U.S. Patent 6,151,137 to Henrick (claim 9). It is submitted that the Examiner has made a fundamental error in interpreting the teachings of the primary Hughes-Hartogs reference. That reference neither teaches nor suggests significant aspects of the claims under rejection.

The claims under rejection all recite a step of inserting at the location of the sender, into a transmission including an image format portion, data identifying the address of the intended recipient of the image format portion. The Examiner asserts that Hughes-Hartogs, at column 5, lines 9-14, disclose such a step. The reference, however, merely states that the recipient of the facsimile **will be able to recognize the format used**, as the sending system does an image conversion of the data to be sent into a conventional facsimile format. The referenced portion in

no way is directed to identifying the address of the recipient. The claims also recite that message tracking data is inserted into the data transmission. The Examiner contends that such limitation is set forth at column 7, lines 2-8 of the reference. At that location, however, the reference talks, in the alternative, of having module 52 format an outgoing facsimile in a certain manner (without reciting what the format is) or to keep track of accounting information such as facsimile length, destination, etc. Such information, however, is kept at the location of the **sender**. There is again no disclosure whatsoever that such information is inserted into the data transmission itself. The statement that the outgoing transmission can be formatted in "a certain manner" does not teach the inclusion of message tracking data as specifically recited by the claims.

Simply stated, the Hughes-Hartogs reference offers no teaching whatsoever that a data transmission having an image format portion (such as a facsimile transmission) is to include information, as part of the data transmission itself, either identifying the address of the intended recipient of the image format portion or message tracking data. In Hughes-Hartogs, any recipient and tracking data is retained and maintained at the sender and is not transmitted to the recipient within the data transmission. These arguments, with respect to independent claims 1 and 10 and thus by extension to all claims, were set forth in Applicant's Response filed April 2, 2007, pages 304; the Examiner's Final Rejection repeated the Patent Office's position from an earlier Action and did not specifically address Applicant's arguments.

As also recited in detail in the Response, page 4, third full paragraph, Hughes-Hartogs clearly also does not teach the insertion of message tracking data comprising at least one of accounting, audit and documentation data. Because there is no data insertion in the transmission, there certainly can be no insertion of particular data, as recited in either claim 2 or 14. Hughes-Hartogs, at column 7, lines 5-8 once again references information that is maintained at the point

of transmission, not incorporated into the data transmission itself.

Claim 3, in addition to defining the message tracking data as accounting, audit or documentation data, recites a step of processing message tracking data by the intermediate point of presence facility. Again, as Hughes-Hartogs does not include such information in the data transmission, it is unable to be processed by a point of presence facility receiving the transmission. The Examiner contends that the reference at column 5, lines 15-27 defines a fax server 50 as a point of presence device. Yet the server 50, while providing accounting, date stamping, etc., is not disclosed as extracting any of such information from data in the received fax. Rather, it utilizes a three-digit address which is a three-digit portion of the telephone number associated with the sending fax machine. This is not information that is part of the data transmission. See Applicant's Response page 4, last paragraph.

Rejected claim 4 requires the further step of stripping message-tracking data from the transmission before the data transmission is re-transmitted. Once again, as the data transmission in Hughes-Hartogs does not include tracking data, there is clearly neither teaching nor even suggestion in the reference of stripping such information from the transmission. Accounting information compiled by the fax server is not disclosed as being incorporated in a fax transmission, but is conventional information otherwise generated and collected. See Response page 5, first full paragraph.

Claim 5 adds the limitation to the methodology of claim 1 that the data transmission data inserted identifies an address of the sender, and that a confirmation message to that address is sent by the point of presence facility after the data comprising the image portion has been re-transmitted to the recipient's address. While Hughes-Hartogs discloses sending a confirmation message, it offers no disclosure that the confirmation message is sent to the sender. Indeed, the

Examiner in the Final Action repeated his statement from the prior Action that “the faxed document is emailed to the recipient”, (not the sender)!

Claims 6 and 7 include further limitations (to claim 1 and claim 4, respectively) that the address of the recipient is an email address and the step of re-transmitting the data from the point of presence includes forwarding the data in the form of an email attachment to the recipient's email address. While Hughes-Hartogs discloses the further transmission of an incoming fax to a recipient by email, the address of the recipient is **not** inserted at the location of the sender. The reference states only that the fax number associated with particular computers can be the same as an email address for the computers. The email address is **not** embedded in the received transmission but is external thereto.

Claim 12 adds to the requirements of independent claim 10 that the original transmission of the data from the sender to the point of presence facility is in the form of an email. Hughes-Hartogs does not disclose any methodology wherein a transmission from the sender to the point of presence facility is in the form of an email. The Examiner references column 5, lines 35-43 in support of his position of anticipation, but that disclosure relates to passing the facsimile received by the fax server (serving as a point of presence) to a recipient in the form of an email. The original transmission, received by the fax server, is in the form of a conventional facsimile document, which is subsequently converted to an email. The reference does not teach a methodology in which an outward-bound “facsimile” transmission from the sender to an intermediate point of presence facility is in the form of an email transmission.

Claim 9, also dependent on claim 1, is the only claim rejected as being unpatentable and obvious, over Hughes-Hartogs in view of Henrick. Applicant repeats its position with respect to claim 1, as Hughes-Hartogs clearly does not teach the claim 1 requirement of the insertion of

address-identifying data into a data transmission itself. While Henrick teaches the generation and sending of a confirmation message to a sender, this teaching does not address the void left by Hughes-Hartogs. Henrick likewise does not teach or suggest the insertion of address-identifying data into the data transmission itself. The Henrick reference utilizes conventional dialing information, external to the data transmission which is associated with a fax telephone call to capture the telephone number of the sending party and send a confirming message back to that telephone number.

The Examiner has misinterpreted and improperly expanded the teachings of the Hughes-Hartogs reference to justify its use as an anticipatory reference against the present invention. As demonstrated herein, Hughes-Hartogs does not teach (or even suggest) significant aspects of the invention as claimed and accordingly cannot serve as an anticipatory reference. This clear error in fact renders the rejections improper; all present claims of the application are allowable over the references cited.

Respectfully submitted,
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Carol L. Wood, Sender 